

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

IN RE: '318 PATENT INFRINGEMENT
LITIGATION

Civil Action No. 05-356-KAJ
(Consolidated)

**PLAINTIFFS' UNOPPOSED MOTION TO ISSUE LETTERS OF
REQUEST FOR INTERNATIONAL JUDICIAL ASSISTANCE**

Plaintiffs Janssen Pharmaceutica NV, Janssen L.P., and Synaptech, Inc., by its undersigned counsel, hereby respectfully moves the Court to issue the attached Order and Letters of Request (Exhibit 1) requesting international judicial assistance in Germany to enable Plaintiffs to seek the production of documents and take the deposition of a certain witnesses located in Ingelheim, Germany, pursuant to Fed.R.Civ.P. 28(b). Plaintiffs have met and conferred with Defendants in compliance with D. Del. L.R. 7.1.1. Defendants do not oppose this motion to issue letters of request, but reserve the right to oppose any attempt by plaintiffs to extend the discovery schedule in connection with this foreign discovery.

I. Background

Plaintiffs filed suit alleging infringement of the United States Patent No. 4,663,318 (the "'318 patent") by certain foreign and domestic generic pharmaceutical manufacturers ("Defendants"). Plaintiffs currently assert two claims against Defendants: claims 1 and 4. On December 2, 2005, the parties entered into a Stipulation Not to Contest Infringement of these claims. Defendants have asserted, among their affirmative defenses and counterclaims, and in their Paragraph 4 notices, that claims 1 and 4 of the '318 patent are invalid. Among the grounds for invalidity, Defendants assert that the invention described in asserted claims 1 and 4 of the

'318 patent were obvious to one skilled in the art at the time the patent application was filed. Plaintiffs dispute these claims, and maintain that claims 1 and 4 of the '318 patent are valid.

To combat Defendants' claims that claims 1 and 4 of the '318 patent are invalid, Plaintiffs intend to offer at trial objective evidence of the nonobviousness of the '318 patent. This objective evidence includes evidence of skepticism of those skilled in the art about the likelihood of success of the invention described in the asserted claims of the '318 patent, such as the evaluation of whether to license the '318 patent by those skilled in the art. As explained below, Plaintiffs have reason to believe that Boehringer-Ingelheim KG ("Boehringer") evaluated whether to develop a galantamine-based treatment for Alzheimer's disease, considered an opportunity to license the '318 patent from Synaptech, but decided to do neither. Thus, Boehringer has unique information relating to nonobviousness, and a just disposition of this case requires the discovery of documents and testimony from a representative of Boehringer.

II. Standard of Review

A party which seeks the application of the Hague Evidence Convention procedures rather than the Federal Rules of Civil Procedure bears the burden of persuading the trial court of the necessity of proceeding pursuant to the Hague Evidence Convention. *See Tulip Computers Int'l B.V. v. Dell Computer Corp.*, 254 F.Supp.2d 469, 474 (D. Del. 2003). As this court has already recognized, "that burden is not great, however, since the 'Convention procedures are available whenever they will facilitate the gathering of evidence by the means authorized in the Convention.'" *Id.* (citing *Societe Nationale Industrielle Aerospatiale v. United States District Court for the District of Iowa*, 482 U.S. 522, 538, 107 S.Ct. 2542, 96 L.Ed.2d 461 (1987)).

III. Discussion

Plaintiffs' motion is made in conformity with the Hague Convention on the Taking of Evidence Abroad in Civil or Commercial Matters, opened for signature, Mar. 18, 1970, 23

U.S.T. 2555, T.I.A.S. No. 7444, *reprinted following* 28 U.S.C.A. § 1781 (“the Hague Convention”).

A. Plaintiffs have Complied with the Requirements of Article 3(d) of the Hague Convention.

Pursuant to the Hague Convention, a Letter of Request must provide the contracting state with certain information regarding the lawsuit and the information sought. Article 3(d) specifically states that a Letter of Request shall specify “the evidence to be obtained or other judicial act to be performed.” Hague Evidence Convention, 23 U.S.T. 2555, Art. 3(d) (1972). *Abbot Laboratories, Inc. v. Impax*, 2004 WL 1622223 at 2 (D. Del). The attached letter of request does just that.

As a preliminary matter, the Plaintiffs note that it does not seek these discovery of these documents or deposition merely as evidence in the nature of pre-trial discovery, but rather as evidence in the nature of proof to be used at trial. Plaintiffs have carefully crafted the proposed Letter of Request to address specific issues for trial. Moreover, the information that the Plaintiffs seek to obtain from Boehringer is neither wide-ranging nor speculative, but precisely targeted to obtain testimony important to the resolution of this case.

The proposed Letter of Request sets forth in detail the documents to be obtained from Boehringer and the topics to be discussed with Prof. E. Muller or any other appropriate Boehringer representative. The requests are limited in scope to the ‘318 patent and the treatment of Alzheimer’s disease through galanthamine for the purpose of establishing the validity of the ‘318 patent. Plaintiffs additionally provide further detail to their request by referencing and attaching the particular documents and quotations from the documents to which they will seek additional discovery and to which they request the opportunity to ask questions of the deponents. Thus, Plaintiffs have complied with Article 3 of the Hague Convention for issuance of a letter of request.

B. The Request is Necessary to Obtain Relevant Discovery and Trial Evidence.

These documents and this testimony would be a important component to Plaintiffs proof of the validity of the asserted claims of the '318 patent. Based on their investigation, Plaintiffs have learned that Prof. E. Muller and Boehringer have information relevant to this litigation. On November 8, 1989, Muller and Boehringer considered and rejected the opportunity to develop a galantamine product for the treatment of Alzheimer's disease. *See* Attachment 2 to Exhibit 1. In particular, they gave "serious consideration" to the proposal to develop galantamine for an Alzheimer's indication and evaluated "preclinical research data available" to conclude that galanthamine "does not have the biochemical and pharmacological profile ... essential for its potential use in the treatment of Alzheimer's disease." Furthermore, Muller and Boehringer entered into a Confidentiality Agreement on November 10, 1989, with Dr. Bonnie Davis, the inventor of the '318 patent, to evaluate and analyze the prospect of using galantamine to treat Alzheimer's disease. *See* Attachment 3 to Exhibit 2. Accordingly, Muller and Boehringer possess an abundance of information relevant to the issues this case.

IV. Conclusion

Thus, because Boehringer is a non-party not within the jurisdiction of this court or any US district court and is located overseas, Plaintiffs seek a letter of request so that they may procure evidence and testimony for use at trial. As such the Hague Convention is appropriate here, as the witnesses are not parties to the lawsuit, have not voluntarily subjected themselves to discovery, are citizens of Germany, and are not otherwise subject to the jurisdiction of this court. *See Tulip Computers Int'l B.V. v. Dell Computer Corp.*, 254 F.Supp.2d 469, 474 (D.Del. 2003). Accordingly, Plaintiffs request that this Court issue the attached Letters of Request, and that the executed Letters be returned to counsel for Plaintiffs for delivery to the proper authority.

ASHBY & GEDDES

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ORDER

This matter comes before the Court upon Plaintiffs' Motion to Issue Letter of Request for International Judicial Assistance. Having reviewed the notice, and being fully advised in the premises, the Court grants Plaintiffs application for Letter of Request requesting assistance from the appropriate judicial authority of Germany for the obtaining of documents and the taking of depositions of Prof. E. Muller and Boehringer Ingelheim KG. The executed Letters of Request with the Seal of the Court are attached. Plaintiffs shall forward the Letters of Request and any and all necessary translations and copies to the appropriate authorities.

SO ORDERED this _____ day of _____, 2006.

United States District Judge

CERTIFICATE OF SERVICE

I hereby certify that on the 28th day of April, 2006, the attached **PLAINTIFFS'**
UNOPPOSED MOTION TO ISSUE LETTERS OF REQUEST FOR INTERNATIONAL
JUDICIAL ASSISTANCE was served upon the below-named counsel of record at the address
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